REMARKS and ARGUMENTS

Claims 1-48 were presented for appeal. The Examiner has pulled this case from appeal and prosecution has been re-opened. All claims stand rejected under new grounds of rejection. Claim 25 has been amended. Claims 10, 22, 34 and 46 have been canceled. Four new claims, 49 – 52, have been added to reflect a limitation of three or more ring hierarchy levels. Such limitation is not disclosed, suggested, nor taught by the cited references.

Terminal Disclaimer

A terminal disclaimer is being filed herewith in order to address the provisional non-statutory double-patenting rejection of Claims 1-48. Accordingly, such rejections have been overcome.

Claim Rejections -35 USC § 101

The Examiner has rejected claims 1 – 12 and 25 - 36 under 35 U.S.C. 101 as allegedly being directed to non-statutory subject matter.

Regarding Claim 1 (and its dependent claims), the Office Action states that the claim "teaches solely to a set of software modules, with [sic] constitutes functional descriptive material that is not tangibly embodied." (Office Action, para. 4). Applicants disagree, and request that this rejection be withdrawn. The specification makes it clear that the elements recited in claim 1 may be either software or hardware. Thus, Claim 1 does not solely teach a set of software modules. Please see lines 18 – 25 at page 18 of the Application (emphasis added):

> The usage of the software environment 210 or the usage of the subset 230 is
> protected by the usage protector 250. The usage protector 250 uses the OSNK
> 203 to protect the usage of the subset 230. The software environment 210 may

include an operating system (e.g., a Windows operating system, a Windows 95 operating system, a Windows 98 operating system, a Windows NT operating system, Windows 2000 operating system) or a data base. The subset 230 may be a registry in the Windows operating system or a subset of a database. ***Elements can be implemented in hardware or software.***

Accordingly, the usage protector is disclosed as being implemented as, or at least having elements implemented as, either software or hardware.

For example, Figs. 3A, 3B, and 3C each show that a usage protector 250 includes storage (see 398, 310, and 322). In addition, 3B shows that at least one embodiment of a usage protector 250 includes a comparator 315. Claim 1 is not, therefore, directed solely toward software modules. The rejection of Claims 1 – 12 should therefore be withdrawn.

The Examiner has also rejected Claim 25 and its dependent claims (Claims 26 – 36) due to the potential inclusion of intangible carrier waves in the scope of such claims. Claim 25 has been amended to include the term from the specification, "processor readable medium," instead of the term "computer useable medium", which the Office Action pointed out as slightly confusing.

In addition, the Applicants have amended Claim 25 to make clear that only tangible embodiments are claimed. The rejection of Claim 25, and dependent claims 26 – 36, have thus been overcome. The rejection of Claims 25 – 36 should therefore be withdrawn.

Claim Rejections -35 USC § 112, second paragraph

The Office Action has rejected Claims 10, 22, 34 and 46 as indefinite because they contain the WINDOWS trademark/trade name. Claims 10, 22, 34 and 46 have been canceled. The rejections are thus moot.

Claim Rejections -35 USC § 103(a)

The Office Action has rejected Claims 1 - 48 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,421,006 to Jablon et al. ("Jablon") in further view of U.S. Pat. No. 6,327,652 to England et al. ("England"). However, the Office Action has failed to make a prima facie case of obviousness for the claims, and such rejections should be withdrawn.

The legal requirements for a prima facie case of obviousness are clear. "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness." MPEP § 2142. It is well established that *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144).

The Office Action has not met these requirements.

Claims 1, 13, 25 and 37. The prior art references cited by the Office Action do not either alone or in combination disclose, teach or suggest all the claim limitations of Claim 1.

Jablon discloses a method and device that prevents execution of corrupted programs at the time of system initialization (See Abstract; see also Col. 1, lines 10 – 12: "an improved method and device for assessing the integrity of computer software during the system initialization process").

Jablon does not disclose, regarding Claims 1, 13, 25 and 37, "the OS nub further being associated with a ring hierarchy level." The Applicants' reasoning on this point is set forth in

Section A(i) of the Argument section of their Appeal Brief; such arguments are re-asserted herein.

The Office Action's arguments on this point are not availing. The Office Action points out that Jablon states at Col. 10, lines 19 -24 that "the invention can be modified for use in many other computer systems." This alone, however, does not teach, disclose or suggest the specific limitation claimed in Claims 1, 13, 25 and 37. As is stated above, the requirements on this point are clear – *all* of the specific limitations must be taught in the references. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144). "Many other computer systems" does not teach, suggest or disclose the specific limitation of "the OS nub further being associated with a ring hierarchy level."

The Office Action next attempts to resolve this deficiency in its prima facie case of obviousness by stating that "any mechanism that is operable among the hierarchical rings in a ringed architecture and offers greater security in inter-ring accessing would also be advantageous." Office Action, para. 8. The Office Action relies on Jablon's discussion of UNIX to support this argument. However, a prima facie case of obviousness is simply not made out here.

The Office Action admits that "Jablon only discloses a ringless embodiment (using DOS)." Office Action, p. 6. So, the only way to make out a prima facie case of obviousness is if Jablon teaches toward a "the OS nub further being associated with a ring hierarchy level" or if another cited reference discloses, teaches, or suggests the limitation. Neither is true.

The Office Action asserts that Jablon "specifically notes a ringed operating system, UNIX, that would benefit from the Jablon's [sic] invention (see column 3, lines 12-23)." The Office Action further asserts that "it must be concluded from Jablon's observations pertaining to

UNIX's security flaws that Jablon does not consider UNIX's protection architecture to be "strong." This is simply erroneous. Jablon specifically states that the integrity of trusted software in the UNIX system cannot always be guaranteed *"despite* ..[its] architectural strength." Jablon, Col. 3, l. 12-15 (emphasis added).

Bottom line: Unix is disclosed in Jablon as having a strong architecture, and the Jablon '006 makes it clear that **"our invention"** is directed toward assessing the integrity of transient software that "allow[s] systems **without strong protection architecture** to nevertheless use strong security methods during system initialization." Col. 7, lines 21 – 24 (emphasis added).

Jablon thus teaches away from using its invention on a ringed architecture (such as UNIX) which is categorized as having architectural strength. Jablon simply does not disclose, suggest, or teach toward "the OS nub further being associated with a ring hierarchy level."

The Office Action admits that Jablon also fails to disclose a unique key for each program portion. In addition, the Office Action concedes that Jablon does not disclose a key generator.

England pertains to a method for identifying the operating system running on a computer, based on "an identity associated with an initial component for the operating system, combined with identities of components that are loaded afterwards." In particular, after digital signatures for each component are validated, the operating system (referred to as a "digital rights management operating system" or "DRMOS") may assume a trusted identity (Abstract). As far as it goes, England appears to describe reasonable facets of a possible approach to supporting digital rights management. However, the pending claims recite elements that are not disclosed, taught, nor suggested by England (or by Jablon).

For example, England does not teach, suggest or disclose, "the OS nub further being associated with a ring hierarchy level." Thus, a prima facie case of obviousness has not been

made out with respect to Claims 1-48 because neither Jablon nor England, either alone or in combination, teach, disclose or suggest all the limitations of Claims 1-48.

In particular, regarding Claims 1, 13, 25 and 37, Jablon and England at least fail to disclose, teach or suggest the following limitation: "the OS nub further being associated with a ring hierarchy level." For at least this reason, independent claims 1, 13, 25 and 37 are allowable. Also for at least this reason, claims 2 – 12, 14 – 24, 26 – 36, and 38 – 48, which depend from the independent claims are also allowable.

Applicants have willingly amended the claims to address those rejections of the Office Action that appeared well-founded. As a result, Claims 10, 22, 34 and 46 have been canceled, a terminal disclaimer is to be filed herewith, and Claim 25 has been amended. However, Applicants are strongly convinced that a prima facie case of obviousness has not been made out with respect to the remaining claims in the case. All claims are therefore in condition for allowance.

Accordingly, Applicants respectfully submit that the applicable rejections have been overcome and must all be withdrawn. Applicants reserve all rights with respect to the application of the doctrine equivalents. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the Examiner feels that an interview would help to resolve any remaining issues in the case, the Examiner is invited to contact Shireen Bacon of Intel, at (512) 732-3917.

Please charge any shortages and credit any overcharges to our Deposit Account No. 02-2666.

Respectfully submitted,

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